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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1943

CELANESE CORPORATION OF AMERICA,
Petitioner-Plaintiff,
vs.
LIBBEY-OWENS-FORD GLASS COMPANY,
Respondent-Defendant.

No. 149

DEFENDANT'S BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI.

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As to the third reason advanced for allowance of the writ (which is in addition to "Questions Presented"), the Court of Appeals properly held the patent in suit invalid on five grounds. The Court found that the findings of the Master were supported by "substantial and persuasive evidence" and "overwhelming evidence" 3

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DEFENDANT'S BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI.*

This is the usual patent infringement suit. It presents none of the grounds for certiorari stated in Rule 38 (5b) of the rules of this Court.

"QUESTIONS PRESENTED" by plaintiff are two (Pet., p. 2). Both of these are false issues. Further, whether real or false, they are not determinative.

The first question, as to whether the Walsh patent in suit is for laminated glass or chemical compound, is a false issue. The Court of Appeals did not misapprehend the subject-matter of the patent. The Court did not misapprehend the plaintiff's contentions. The same contentions urged in the petition were made before the Court of Appeals and the Master. Directly and specifically the Court of Appeals referred to safety or laminated glass twenty-eight times. The Court states:

*The petitioner will be referred to as "plaintiff" and the respondent will be referred to as "defendant."

"Plaintiff is most insistent that what was known about plastics is not to be confused with what was known about laminated glass" (R. 1909).

The second question stated by plaintiff (Pet., p. 2) goes only to infringement. The Walsh patent is plainly invalid on the several grounds stated by the Court of Appeals and on other grounds (see page 3 post). The question of infringement does not require decision. If it did, the patent is limited to 50-75% by weight of softener (plastifier or plasticizer) for 100% of cellulose base.* As to these limitations the Court of Appeals held that "plaintiff is confronted by file wrapper estoppel" inasmuch as Walsh inserted these limitations to get the claims allowed. (See C. C. A. opinion, R. 1915-16; also R. 1052, 1058, 1068.)** Defendant's articles and processes outside this range cannot infringe. Further, defendant could not infringe because it uses a softener, dimethyl phthalate, which is not set forth anywhere in the Walsh patent and is not the equivalent of any of the softeners which are set forth in the Walsh patent (see C. C. A. opinion, R. 1913; also R. 244).

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*Claim 1, a representative claim, reads (R. 830): "Laminated glass having sheets of glass united by a plastic composition containing a derivative of cellulose and 50-75%, based on the cellulose derivative, of non-volatile plastifier selected from the group consisting of dibutyl phthalate, diethyl phthalate, dibutyl tartrate and triacetin to render the same flowable under heat and pressure."

**To obtain allowance of the claims with these definite limitations, the same contentions urged in the petition as to the advantages of a "soft," "rubbery" interlayer were presented to the Patent Office and, as noted by the Court of Appeals, were relied upon by the Patent Office officials. However, the Master and Court of Appeals found these contentions to be contrary to fact (R. 1918).

The argument made respecting *Winans* v. *Denmead* (Pet., pp. 12-13) is not pertinent because the doctrine of equivalents may not be resorted to for the purpose of giving to claims a breadth which the patentee abandoned in order to get the patent issued (*Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U. S. 211; 1940). Plaintiff's "Question 2" is a moot question because of the invalidity of the claims.

As to "Reasons Relied Upon for the Allowance of the Writ of Certiorari" (Pet., p. 3), item 3 thereunder is in addition to "Questions Presented." The first part of item 3 relates to patentable invention and the second to scope. Scope has been sufficiently covered above.

In respect to patentable invention, the Court of Appeals held that the claims in suit of the Walsh patent are invalid because

1. anticipated by the prior art;

2. broader than the alleged invention; they cover many inoperable combinations;

3. the method claims specify an impractical process, lacking utility;

4. the patent lacks sufficient disclosure; it is based on a "hit or miss formula" (R. 1918);

5. the 50-75% limits in the claims are not critical and define no invention.

With respect to (1), anticipation, the Court of Appeals held that there was "substantial and persuasive evidence

to sustain the findings of the Master"* in this regard (R. 1918).**

Even if Walsh proposed a novel degree of "softness" of interlayer (which is contrary to fact), his change from the

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*The Master's Report is at R. 1807-48.

**The alleged novelty, as urged in the petition and before the Court of Appeals, is a "soft, rubber-like interlayer" (Pet., p. 4). Interlayers of the prior art laminated glass were softer than some of Walsh's interlayers. See R. 522-9; Plaintiff's Ex. 56, R. 859, which shows that a prior art interlayer of 40.2 parts of softener is softer than a Walsh interlayer of 50.2 parts of softener (cf. items 42 and 30 on Plaintiff's Ex. 56). See also R. 355-66; Defendant's Exhibits WWW and VVV, R. 1423, 1421. The Shuman prior art patent (R. 1149, lines 58-59) shows that the prior art well knew that the interlayer should be soft enough to mold to the glass. The Dreyfus patent (R. 1149-62) shows that the art knew that interlayers could be made softer by adding more softener. See also the Brier prior art patent (R. 1235). See R. 146-7, 464-5, where plaintiff's expert identified prior art commercial interlayers as "more rubbery" than the prior art interlayers and within the softness range of Walsh. With respect to this, the Court of Appeals said: " . . . such testimony indicated that the hardness of the plastic sheets was not the problem solved, or to be solved" (R. 1912). Also, "The problem of hardness was not pivotal; and the solution of the difficulties did not depend upon softness and flowability of the composition" (R. 1918).

The plaintiff erroneously says (Pet., p. 5) that the *entire* prior art (commercial, patent, and publication) employed only a cellulose nitrate-camphor interlayer. Those prior art patents discussed by the Court of Appeals are enough by way of illustration to refute this wholly erroneous statement by plaintiff. We, therefore, shall not list the many prior art patents in the record disclosing interlayers other than cellulose nitrate-camphor.

prior art would be only one of degree of softness for the same purpose. This would not involve invention.*

The plaintiff's effort to make capital out of Walsh's so-called "non-volatile" softeners (Pet., p. 8) is groundless.**

Regarding (2), the inoperable combinations claimed, the Court of Appeals found that "there was a mass of substantial and persuasive evidence that many of the named plastifiers do not work with, or plastify the various cellulose derivatives designated to be used by Walsh" (R. 1910).*** This was termed by the Court as "overwhelming evidence" (R. 1919).

With respect to (3), lack of utility of the method claims, the Court of Appeals found "the method itself is impractical . . . according to plaintiff's expert witness . . . " (R. 1919).****

With respect to (4), lack of sufficient disclosure, the Court of Appeals held:

> "The evidence in this case discloses that the Walsh patent was based on a hit or miss formula, which was

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*_Brady Brass Co._ v. _Ajax Metal Co.,_ 160 Fed. 84, 85 (C. C. A. 3; 1908; certiorari denied 210 U. S. 433).

**The Circuit Court of Appeals said that prior to Walsh, "It was known which plastifiers were more volatile than others, and it was also known that certain plastifiers would work more satisfactorily with some cellulose derivatives than with others" (R. 1909). See R. 341-2, 428-30.

***See R. 466, 104, 105-6, 297-301, 309. The Court of Appeals found that some of Walsh's claimed interlayers were "hard, opaque, brittle, flaky, and unstable; some of them turned to powder when they were cut or sliced; others were thick, 'cheesey' " (R. 1910).

****R. 86.

> not such a disclosure to those skilled in the plastic composition art or laminated glass art, as would enable them to practice its manufacture without experiment" (R. 1918).*

Regarding (5), the non-critical 50-75% limits in the claims, the Court of Appeals held:

> "While it is claimed that the proportions stated were critical, it appears otherwise from the evidence" (R. 1916).**

The defendant took nothing from the plaintiff. Plaintiff had nothing to give.

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*See R. 466, 104, 105-6, 297-301, 309, 355-66.

The Court of Appeals also said (R. 1915): "But, were we to assume (contrary to the Master's findings) that the use of such soft plastics in laminated glass was a novel contribution to the art, we are met by the fact that the patentee has claimed a great chemical kingdom; that within the ever contracting and expanding boundaries set by him, are multiform compounds that have none of the attributes necessary for the purposes of the claimed invention; that even among many of the compositions submitted as suitable for such purposes, numerous of them failed, being discolored, with bubbles and unlaminated spots; that the most successful of the compounds are found only by continuous experimentation; but that, nevertheless, it is sought to impress a title and ownership upon anything discovered by others within the unexplored regions of this vague domain."

**The plaintiff's expert witness testified that changes upon use of plastifier above 75% are gradual, and that "there are no sharp lines where you can say, 'this sheet works and that sheet does not.' It is a matter of relative degree" (R. 120). With respect to the lower limit of 50% the plaintiff's expert stated that changes below 50% are a matter of degree only; that 48 might do as well as 50 (R. 116).

As to the softeners set forth in the patent specification, the Master found as a fact that the record "does not disclose that a plastic interlayer for laminated glass using any one of the four plasticizers mentioned by Walsh as the sole plasticizer has ever been successfully used commercially by anyone" (Fact Finding 18, R. 1846).

The defendant has long been a large manufacturer of laminated glass. For years, as did other large manufacturers, it successfully made the product using cellulose nitrate interlayers. Defendant bought large quantities of cellulose nitrate interlayers from plaintiff which, in competition with other large concerns, was a manufacturer of plastics (R. 630, 411).

Defendant was anxious to improve the quality of its product. This could be done by using a cellulose acetate interlayer which was inherently weaker than cellulose nitrate but more retentive of clarity under thermal changes and sunlight action (R. 347-8).

Plaintiff endeavored to supply defendant with a satisfactory cellulose acetate interlayer. It failed. Though the Walsh patent application was filed in 1928, as late as 1930 (as the Court of Appeals points out in its opinion), defendant and other companies were corresponding, negotiating, and conferring with the plaintiff in an attempt to secure satisfactory cellulose acetate sheets for interlayers (R. 1914). In 1932 plaintiff advised that "cellulose acetate has not been perfected for laminated glass" (R. 1914; 1495). The Walsh patent application gave no help. As late as 1933 plaintiff was still unsuccessfully working on the problem.

Meanwhile one of plaintiff's competitors in the plastic field succeeded in producing satisfactory cellulose acetate interlayers for laminated glass. Defendant bought this

from plaintiff's competitor. It developed an adhesive for it (R. 343). An adhesive is necessary. The Walsh patent disclosed none that works with a cellulose acetate interlayer. In May, 1932, without any disclosure to it by plaintiff of the pending Walsh patent application, defendant began using these interlayers in its product (R. 410). It is only the defendant's cellulose acetate products and processes that are charged to infringe.

Eight months after plaintiff learned of this, which was five years after the Walsh patent application was filed, plaintiff sought to reap where it had not sown. It added Claims 3, 4, 6, and 7 to the Walsh application (R. 1085-88; 637). The four specific softeners mentioned in the patent specification gave no foundation for its endeavor in Claims 3, 4, 6, and 7 to broadly claim hundreds of softeners. This lack of emergence of these claims from the specification is another reason why the Walsh patent is invalid. The unconscionable nature of plaintiff's belated endeavor to take toll through grinding no grist is not to be tolerated. In mentioning some of these matters, the Court of Appeals in its opinion concludes with this observation:

> " . . . It is difficult to draw any inferences from the foregoing, except that those skilled in the art were unable to find from Walsh's specifications and claims, the suitable plastifiers, the particular derivatives, and the proper proportions of each for the desired composition, without multitudinous experiments" (R. 1914).

This presents still another reason why the Walsh patent is void.

The Walsh patent is plainly invalid. The Master's findings of fact were well grounded. The Circuit Court of

Appeals' opinion discloses a thorough understanding of the cause. Its determinations are abundantly supported on the record.

Respectfully submitted,

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